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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/610,158	06/30/2000	William J. Veeneman	013212.0137R1US	3096

24283 7590 08/20/2010

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EXAMINER	
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ART UNIT	PAPER NUMBER
3628	

MAIL DATE	DELIVERY MODE
08/20/2010	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM J. VEENEMAN, BARBARA THOMAS, and
DEBRA REMINGTON

Appeal 2010-006606
Application 09/610,158
Patent 5,774,874
Technology Center 3600

Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*, and LINDA E. HORNER and KEN B. BARRETT, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

William J. Veeneman et al. (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of July 9, 2008 in reissue application 09/610,158.[2] The reissue application seeks to reissue U.S. Patent 5,774,874 ("the '874 patent"), issued June 30, 1998, based on application 08/562,014 ("the '014 application"), filed November 22, 1995.[3]

The reissue application contains claims 9-14. Claims 1-8 and 15-29 have been canceled. The Examiner has rejected claims 9-14, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

THE INVENTION

Appellants' claimed invention is a multi-merchant gift registry system and method. '874 patent, col. 1, ll. 17-19. Claim 9, reproduced below, is representative of the subject matter on appeal.[4]

> 9. A system for registering items selected by a registrant from a plurality of participating merchants for subsequent communication to a prospective purchaser, the system comprising:

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[2] A related appeal in co-pending reissue application 10/940,094 is pending before the Board as Appeal 2010-010507. The '094 reissue application is a continuation of the '158 reissue application.

[3] The '014 application is a continuation-in-part of Application 08/132,604, filed October 6, 1993, now abandoned, which is a continuation-in-part of Application 08/062,470, filed May 14, 1993, now abandoned.

[4] This claim shows by underlining and bracketing additions and deletions made to patented claim 9 in the reissue application.

> a gift registry [kiosk disposed proximate the stores of a plurality of merchants in a shopping area, each of said merchants participating in the gift registry, the gift registry kiosk having a] computer system containing identifying information about a registrant, the information for each registrant including at least [one name for the registrant] the registrant's name and a list of potential gifts which the registrant has identified;
>
> a portable input and storage device for use by the registrant with a plurality of participating merchants, the input and storage device being capable of receiving and storing information regarding the registrant's desired gifts including the merchant each desired gift is from, wherein the input and storage device stores a unique identifier for the particular merchant each desired gift is from;
>
> a transfer device connected to the gift registry computer system that receives the information regarding the registrant's desired gifts from the portable input and storage device and transfers the information to the gift registry computer system; and
>
> a prospective purchaser interface device that allows a prospective purchaser to view a list of the goods desired by the registrant wherein the list includes information about the particular merchant each gift is from.

THE EVIDENCE

The Examiner relies upon the following evidence:

McCalley US 5,113,496 May 12, 1992

Here Comes The (New) Bridal Registry, CHAIN STORE AGE EXECUTIVE, October 1992 (hereinafter "Chain Store Age").

Nancy Brumback & Jeff Malester, *Electronic Shopping Makes the Retail Connection*, 57 RETAIL HOME FURNISHINGS October 31, 1983 at 8 (hereinafter "Brumback").

THE REJECTIONS

Appellants seek review of the following rejections:

1. The Examiner rejected claims 9-12 under 35 U.S.C. § 251 as being improper recapture of broadened subject matter surrendered in the application for patent upon which the present reissue is based.
2. The Examiner rejected claims 9-14 under 35 U.S.C. § 103(a) as being unpatentable over Chain Store Age and McCalley.
3. The Examiner rejected claims 9-14 under 35 U.S.C. § 103(a) as being unpatentable over Chain Store Age and Brumback.

Additionally, the Examiner rejected claims 9-14 on the ground of statutory (35 U.S.C. § 101) double patenting as being in conflict with claims 1-8 and 15-29 of co-pending reissue Application 10/940,094. Ans. 5. Appellants present no arguments against this rejection, and as such, Appellants have waived any argument of error regarding the rejection. We summarily sustain this rejection.

ISSUES

The issues presented by this appeal are:

1. Do claims 9-12 impermissibly recapture subject matter surrendered during prosecution of the '874 patent?

2. Would the proposed combination of Chain Store Age and either McCalley or Brumback have rendered obvious a system including a portable input and storage device which receives and stores information regarding the merchant each desired gift is from and stores a unique identifier for the particular merchant each desired gift is from, and further including an

interface device that provides a list of goods which includes information about the particular merchant each gift is from?

I. RECAPTURE REJECTION

A. FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence.

1. Appellants filed the '014 application containing original prosecution claims 1-14.
2. The Examiner rejected claims 1-14 under 35 U.S.C. § 103 as being unpatentable over Chain Store Age and Appellants' Admitted Prior Art. Office Action dated June 20, 1997.
3. Appellants filed an Amendment in response to the Office Action in which Appellants amended claim 9 as set forth below:

> 9. (Amended) A system for registering items selected by a registrant from a plurality of participating merchants for subsequent communication to a prospective purchaser, the system comprising:
>
> a gift registry kiosk disposed proximate the stores of a plurality of merchants in a shopping area, each of said merchants participating in the gift registry, the gift registry kiosk having a computer system containing identifying information about a registrant, the information for each registrant including at least one name for the registrant and a list of potential gifts which the registrant has identified;
>
> a portable input and storage device for use by the registrant with a plurality of participating merchants, the input and storage device being capable of receiving and

> storing information regarding the registrant's desired gifts including the merchant each desired gift is from, wherein the input and storage device stores a unique identifier for the particular merchant each desired gift is from;
>
> a transfer device connected to the computer system that receives the information regarding the registrant's desired gifts from the portable input and storage device and transfers the information to the computer system; and
>
> a prospective purchaser interface device that allows a prospective purchaser to view a list of the goods desired by the registrant wherein the list includes information about the particular merchant each gift is from.
>
> Amendment dated September 12, 1997, pp. 2-3.

4. Appellants traversed the rejection of claims 1-14 and argued:

> The claims as amended are drawn to a gift registry that serves a plurality of merchants each having a store in a shopping area. Neither Applicants' admitted prior art nor the publication article is drawn to a registry serving a plurality of merchants, each merchant having a store in a shopping area. In fact, the publication article inferentially teaches away from the registry serving a number of stores in a shopping area. The registry in the publication article serves a number of stores under common ownership in a chain of stores. Typically the individual stores making up the chain of stores are located distant from one another in order to attract customers from a number of spatially distant areas, as distinct from the present invention in which the registry serves a number of different stores in a shopping area.
>
> Amendment dated September 12, 1997, p. 5.

B. PRINCIPLES OF LAW

What has become known as the "recapture rule," prevents a patentee from regaining through a reissue patent subject matter that the patentee surrendered in an effort to obtain allowance of claims in the patent sought to be reissued. *In re Clement*, 131 F.3d 1464, 1468 (Fed. Cir. 1997).

If a patentee attempts to "recapture" what the patentee previously surrendered in order to obtain allowance of original patent claims, that "deliberate withdrawal or amendment … cannot be said to involve the inadvertence or mistake contemplated by 35 U.S.C. § 251, and is not an error of the kind which will justify the granting of a reissue patent which includes the [subject] matter withdrawn." *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995 (Fed. Cir. 1993) (quoting *Haliczer v. United States*, 356 F.2d 541, 545 (Ct. Cl. 1966)); *see also Hester Indus., Inc. v. Stein, Inc.*, 142 F.3d 1472, 1480 (Fed. Cir. 1998).

The Federal Circuit's opinion in *Clement* discusses a three-step test for analyzing recapture.

Step 1 involves a determination of "whether and in what 'aspect' any claims sought to be reissued are broader than the patent claims." 131 F.3d at 1468.

Step 2 involves a determination of whether the broader aspects of the reissue application claims relate to surrendered subject matter. *Id.* at 1468-69. In this respect, review of arguments and/or amendments during the prosecution history of the application, which matured into the patent sought to be reissued, is appropriate. In reviewing the prosecution history, the

Federal Circuit observed that "[d]eliberately canceling or amending a claim in an effort to overcome a [prior art] reference strongly suggests that the applicant admits that the scope of the claim before cancellation or amendment is unpatentable." *Id.* at 1469. *See also Hester Indus.*, 142 F.3d at 1481 ("an amendment to overcome a prior art rejection evidences an admission that the claim was not patentable" (citations omitted)).

Step 3 of the *Clement* test is applied when the broadening relates to surrendered subject matter and involves a determination of "whether the surrendered subject matter has crept into the reissue application claim." 131 F.3d at 1469 (citations omitted).

C. ANALYSIS

Appellants argue claims 9-12 as a group. App. Br. 8-11. We select claim 9 as representative, and claims 10-12 stand or fall with claim 9 for this ground of rejection. *See* 37 C.F.R. § 41.37(c)(1)(vii).

As to the first step of the *Clement* test, reissue claim 9 seeks to delete the claim limitation of a gift registry "kiosk disposed proximate the stores of a plurality of merchants in a shopping area, each of said merchants participating in the gift registry, the gift registry kiosk having a" computer system from patented claim 9. Reissue claim 9 replaces this limitation with "a gift registry computer system." Thus, reissue claim 9 is broader than patented claim 9 in at least two aspects. First, reissue claim 9 does not call for a gift registry "kiosk" that is to be "disposed proximate the stores of a plurality of merchants." Second, reissue claim 9 does not call for the

plurality of merchants participating in the gift registry to be "in a shopping area."

As to the next step of the *Clement* test, this second broadened aspect of reissue claim 9 relates to surrendered subject matter, because (1) Appellants amended original prosecution claim 9 to add the limitation that the plurality of merchants participating in the gift registry are located in a shopping area (Fact 3), and (2) Appellants argued that the requirement that the merchants are located in a shopping area, as opposed to being located in spatially distant areas, such as stores in a group of chain stores, distinguished the invention of amended original prosecution claim 9 from the prior art (Fact 4).

Appellants contend that the arguments made during prosecution of the '874 patent to overcome the prior art were "directed to the distinguishing factor of a gift registry system that serves many merchants, each having a unique identifier, where the gift information is correlated with the selected merchant via the unique merchant identifier." App. Br. 11. We find no such argument in the Amendment dated September 12, 1997 referred to by the Examiner and Appellants. Rather, the arguments in this Amendment distinguish the claimed invention from the prior art by focusing on the distinction between the claimed location of the plurality of merchants' stores "in a shopping area" and the location of the stores in the prior art, which were, according to Appellants, located in spatially distant areas.

As to the third step of the *Clement* test, Appellants have not added any amendments to reissue claim 9 that are narrower in an aspect germane to a

prior art rejection. As such, we find that the recapture rule bars reissue claim 9. Claims 10-12 fall with claim 9.

II. OBVIOUSNESS REJECTIONS

A. FINDINGS OF FACT

We find that the following additional findings are supported by at least a preponderance of the evidence.

5. Chain Store Age describes a computerized gift registry system running on an IBM 3090 mainframe and PC workstations. Chain Store Age, cover page, ll. 31-39.
6. Chain Store Age describes that the bride walks the store with a consultant and picks out items, the consultant scans the SKU number with a handheld, portable laser scanner, and the consultant then downloads the scanner information by batch to the registry computer. Chain Store Age 62, col. 1, ll. 1-10 and ll. 41-43.
7. Customers wishing to purchase items from the registry list use a touch-screen kiosk located in the store. Chain Store Age 62, col. 3, ll. 14-28.
8. Chain Store Age describes that "with the new system, the registries of Dayton's, Hudson's and Marshall Field's are integrated centrally for the first time" and that "[b]etween Dayton's, Hudson's and Marshall Field's, the registry boasts some 62,000 registrants annually, accounting for about $110 million in sales." Chain Store Age 62, col. 1, ll. 63-66; *id.* at cover page, ll. 12-16.

9. As such, Chain Store Age discloses a computerized gift registry system that is used in multiple different stores.

10. Chain Store Age does not specifically disclose using a unique merchant identifier to keep track of which selected gifts on the registry come from which store.

11. McCalley describes customized services for use in an electronic shopping system that simulates many aspects of "live" shopping in a mall and may include: "a personal directory for keeping customized list of items which cross store boundaries"; "a bridal registry server, maintained on a mall-wide basis"; and "a product search server to provide subscribers with the ability to easily find products in a store based upon various input information, e.g. price, sex, age, etc." McCalley, col. 10, ll. 17-20; *id.* at col. 22, ll. 1-14.

12. Brumback discloses an electronic merchandising system in Toronto's Eaton Centre mall in which shoppers, by touching a TV screen in a kiosk in the mall, can ask a computerized directory for a list of gifts for a particular intended recipient (e.g., a small boy who likes sports). The system provides gift suggestions from several stores in the mall on the kiosk screen. Once the customer selects a gift, the system can map and provide directions, via the kiosk screen, to the store in which the selected gift is sold. Brumback 4, ll. 4-14.

13. Brumback discloses that "[t[here seems to be little question among the current experimenters that electronic communication with customers at the point of sale is here to stay." Brumback 4, ll. 4-6.

14. Brumback further states, "A retail service that adapts easily to the electronic age is bridal and gift registry. Filene's Jordan Marsch, Hudson's and Dayton's are upgrading their computerized registries." Brumback 3, ll. 23-25.

B. PRINCIPLES OF LAW

> In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends. Granting patent protection to advances that would occur in the ordinary course without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 419 (2007).

> When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.

KSR, 550 U.S. at 421.

C. ANALYSIS

Chain Store Age and either McCalley or Brumback

For each ground of rejection, Appellants argue claims 9-14 as a group. App. Br. 11-19; and 26-32. We select claim 9 as a representative claim, and claims 10-14 stand or fall with claim 9. *See* 37 C.F.R. § 41.37(c)(1)(vii).

The Examiner found that Chain Store Age discloses a gift registry computer system, a portable input and storage device, a transfer device, and a prospective purchaser interface device substantially as called for in claim 9, except that Chain Store Age does not specifically disclose that the unique identifier for each gift, i.e. the collection of SKU numbers, includes a unique merchant identifier.[5] Ans. 6, 8. The Examiner found that McCalley discloses providing a personal directory for keeping a customized list of gifts which cross store boundaries and providing a bridal registry server maintained on a mall-wide basis. Ans. 7. The Examiner found that this disclosure in McCalley would have suggested associating gifts with a corresponding store on a mall-wide basis and providing a unique merchant identifier. *Id.*

The Examiner further found that Brumback discloses a system that allows shoppers, using a kiosk in the mall, to ask a computerized directory for a list of gift ideas. Ans. 8-9. The directory provides a list of suggested gifts from several stores, and once the customer selects a gift, the computer can map directions from the kiosk to the store having the selected gift. *Id.*

[5] The Examiner found that SKU numbers can be specific to the merchant in the case of a store brand and therefore identified with the merchant.

The Examiner found that this disclosure in Brumback indicates that the computerized directory associates the gifts with a corresponding store in the mall, thus suggesting the use of a unique merchant identifier. *Id.* We agree with the Examiner's findings (Facts 5-7 and 10-12).

Based on these findings, the Examiner determined that it would have been obvious to modify the invention of Chain Store Age to store and display a gift registry including gifts associated with different merchants and to implement this modification using a unique merchant identifier. Ans. 7-8. The Examiner stated that the reason for making this modification is to "provide subscribers with the ability to easily find products in a particular store, . . . thereby increasing customer satisfaction and convenience." Ans. 7, *see also* Ans. 9.

Chain Store Age discloses a system that provides an integrated, centralized gift registry for multiple stores, i.e., Hudson's, Dayton's, and Marshall Field's (Fact 8). While these stores were commonly owned by Dayton Hudson Corporation at the time of the article, they presumably did not all carry the exact same products. The system of Chain Store Age had an integrated central registry for all three stores (Facts 8 & 9). As such, when a customer used the kiosk to retrieve a gift registry from the system, if the registrant had registered for gifts in more than one store served by the registry, then the registry would likely have provided the customer with the name of the store in which the gifts on the registry could be found. While such a disclosure is not explicit in Chain Store Age (Fact 10), it would certainly have been obvious in view of the suggestion in McCalley to

provide specialized services in an electronic shopping system, such as a bridal registry on a mall-wide basis (Fact 11), which of necessity would require the use of a way to identify the store in which each registered gift can be found. As such, we agree with the Examiner's findings and reasoning that it would have been obvious, in view of this suggestion in McCalley, to have modified the system in Chain Store Age to identify the merchant from which the gifts on the registry can be obtained so as to provide this information for the convenience of the customer seeking to purchase a gift on the registry.

Brumback discloses a gift suggestion system, available from a kiosk in a shopping mall, that provides a list of suggested gifts found in various stores in the mall, and then provides the customer with the name of the store and directions to the store in which a selected gift can be found (Fact 12). This gift suggestion system would, of necessity, require the use of a way to identify the store in which the suggested gifts can be found. As such, we also agree with the Examiner's findings and reasoning that it would have been obvious, in view of this suggestion in Brumback, to have modified the system in Chain Store Age to provide a way to identify the merchant from which the gifts on the registry can be obtained so as to provide this information for the convenience of the customer seeking to purchase a gift on the registry.

Further, it appears from the prior art that there was clearly market demand prior to and at the time of Appellants' invention to provide computerized interfaces for gift registries (Facts 13 & 14). The use of a

unique merchant identifier, such as a store number or store name, to identify the merchant from which gifts may be purchased is the epitome of an advance spurred by market demand that would occur in the ordinary course without real innovation. *KSR*, 550 U.S. at 419. In other words, the use of a unique merchant identifier to identify where gifts in a registry can be purchased is likely not the product of innovation but of ordinary skill and common sense. *Id.* at 421. As such, we sustain the Examiner's rejection of claim 9 under § 103 as being unpatentable over Chain Store Age and either McCalley or Brumback. Claims 10-14 fall with claim 9.

CONCLUSIONS

Claims 9-12 impermissibly recapture subject matter surrendered during prosecution of the '874 patent.

The proposed combination of Chain Store Age and either McCalley or Brumback would have rendered obvious a system including a portable input and storage device which receives and stores information regarding the merchant each desired gift is from and stores a unique identifier for the particular merchant each desired gift is from, and further including an interface device that provides a list of goods which includes information about the particular merchant each gift is from.

DECISION

The decision of the Examiner to reject claims 9-14 is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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